

Boyle 1126  
Please add claim 138:

See 1 138. The method of claim 1, wherein the single communication is in a single document.--  
#44F

### Remarks

Applicant has carefully reviewed the Office Action of October 1, 1999, and appreciates the examiner's telephonic clarification of a typographical error in the grounds for rejection, where "claims 156" should read "claims 1-56". Independent claims have been amended to more positively recite identifying features of the invention.

It is Applicant's understanding that the examiner is not asserting any prior art in her rejection of the claims. Only the claims of Applicant's prior pending patent application number 08/661,004 are regarded as posing any issues with regard to patentability of the subject matter of the pending claims. Accordingly, it is Applicant's understanding that once these issues have been addressed, the application should be in condition for allowance.

Before addressing the specific differences between the claims of the present invention and those of the parent application, Applicant presents a brief synopsis of the technology of each application. This explanation is not limiting of the inventions claimed but is provided to assist in an understanding of the differences between them.

The technology disclosed in the parent application, in which the issue fee has been paid, relates to a method and apparatus for preparing customized information regarding individuals whose information is contained in a large data base, for example, the data base of a bank, credit card issuer,

utility company, or large retail organization and the like that may have millions of clients and data about each client. The information from the data base is analyzed and a product, for example a life insurance product, is custom tailored for each of the clients using the parent application's technology. Thus, for example, certain life insurance packages offered to a married male with three children, and with a high income, would be different from the life insurance package designed for a single female college student. The technology of the parent application generates these customized "products" and/or "client messages" that may be delivered to the client by mail, facsimile, e-mail or other suitable means.

The Applicant recognized that in many instances the means for delivery, such as postal delivery, posed a significant financial impediment to implementation of custom direct marketing approaches. Each of the potentially hundreds of thousands (or millions) of product offerings (whether using the parent invention or not) would have to be mailed separately, incurring high postal or other delivery charges. Accordingly, Applicant devoted inventive effort to the development of a less costly means of delivering the customized products or messages.

The instant patent application solves the "delivery cost" problem, among others. It discloses technology for delivering the customized messages or products by including these on a "host vehicle" that is preferably a communication that would ordinarily be routinely sent to the client. For example, in the case where a bank's clientele is being solicited for insurance products, the appropriate customized insurance product (and optional variations on the product) may be included on a standard monthly statement that the bank would routinely send to the client. Obviously, the

technology can also be used by with other establishments that send out routine statements, credit card issuers, utility companies, and any other organization that routinely sends out communications to its own clients (or others).

In view of the foregoing, Applicant respectfully points out that the Office Action's allegation that the instant claims "are broader in scope than the parent application", is not correct. The instant claims include the requirement that the customized message or product ("client communication") be combined with a host vehicle for sending to selected individual clients, from the multitude of clients that may be present on a data base. The term "host vehicle" is introduced at page 5, lines 8-14, that summarizes how it is used in the inventive technology. The specification at page 6, lines 8-20, further expands on the purpose and usefulness of the host vehicle. The original parent application makes no reference to such a host vehicle. Thus, the scope of the present claims is not broader than that of the parent application, but is significantly different.

The Office Action also states that there is "no apparent reason why Applicant would be prevented from presenting claims corresponding to the instant application in the parent". Applicant respectfully traverses this assertion. The parent application does not provide enabling support for the inclusion of customized client communications onto a host vehicle. The Office is respectfully requested to specifically point out those parts of the specification of the parent application that would support the steps requiring the use of a "host vehicle" that was first disclosed in the present application.

In view of the foregoing explanations, Applicant respectfully requests reconsideration and withdrawal of the double patenting rejection, and allowance of all pending claims. Applicant has included a check for the sum of \$40.00 (by mail) to fulfill the deficit in the information disclosure fee.

Respectfully submitted,

*Shaukat Kayaker*

Shaukat A. Karjeker  
Reg. No. 34,049

Enclosure (Check \$40.00) (by mail)

Dated: 11/5/99

SNELL & WILMER L.L.P.  
One Arizona Center  
400 East Van Buren  
Phoenix, Arizona 85004-2202  
Telephone: 602-382-6244